

REMARKS

Reconsideration is respectfully requested.

By the above amendments, the specification has been amended to correct the statement of invention. The reference to the claims of the application have been deleted, and text has been inserted essentially repeating the subject matter set forth in the claims. No new matter is added.

With respect to the rejection under 35 U.S.C. § 102(e) over Sundberg et al., it is initially noted that U.S. Patent No. 6,086,825 issued from an application that was not filed "in the United States before the invention thereof by the Applicant for patent," as is required by 35 U.S.C. § 102(e). That is, the filing date of the Sundberg et al. '8:5 application in the U.S. Patent Office is indicated as being March 23, 1999, which is after the priority date of Applicants' priority German application (June 10, 1998). Thus, the reference itself fails to qualify as prior art under 35 U.S.C. § 102(e) or any other basis for the rejection.

While Applicants do not deny that Sundberg is a continuation application of parent application Serial No. 08/870,944, Applicants also note that the parent application issued as U.S. Patent No. 6,090,251, and it is this reference which may be properly relied upon as the basis of a rejection under 35 U.S.C. § 102(e), since its filing date admittedly predates the priority date of the present application.

A careful comparison of the text of each of the patents has not been performed. However, differences in at least the citation of references are noted, and Applicants consider the citation of and the reliance on the proper reference, that is, U.S. Patent No. 6,090,251, to be necessary to avoid any later issues of identity of disclosure that may

arise. On this ground, Applicants respectfully request the withdrawal of the rejection of Claims 1 and 5-8 and also of the obviousness rejection of Claims 1-9 made under 35 U.S.C. § 103, which also relies on Sundberg et al. '825.

In view of the continuation status of the Sundberg et al. reference, and in order to further advance prosecution of this application, Applicants further respond to the prior art rejections with the following arguments for patentability.

Referring to Figure 7 of Sundberg et al., the Office Action appears to rely on the disclosure that the intersection between the injection channel 76 and channels 78 each constitute an application area, so as to provide the basis to anticipate Claim 1. However, the term "application area," as is clearly recited and defined in Claim 1, is an area which is designed and configured for taking samples by means of a micro-dispenser, i.e., the application areas each can be loaded with a micro-dispenser, as is explained in detail on page 11, paragraph 3. Therefore, the carrier chip has a cover, which leaves open the application areas (cf. page 9, paragraph 2 of the present application).

Therefore, Sundberg neither anticipates nor renders obvious an application area being designed and configured for being loaded with samples by means of a micro-dispenser.

It is respectfully submitted that the Office Action improperly relies on an unsupported statement that "Sundberg would appear to be as capable of separately loading samples into separation channels as the instant invention." Applicants respectfully disagree. Sundberg fails to disclose that the separation channels can be loaded separately. In contradistinction, Sundberg explicitly teaches away from such an interpretation, in that the separation channels 78 are jointly loaded (cf. column 1, lines

44-54). Therefore, any samples in the injection channel 76 will be loaded into all separation channels, according to the disclosure of Sundberg.

Thus at least the following limitations are not described or shown by Sundberg et al.:

- 1) The separation channels 78 of Sundberg et al. (Fig. 7) cannot be loaded separately with samples, see, for example, column 9, lines 43-60 and above.
- 2) There are no application areas provided at the crossing points of the separation channel 78 and the injection channels 76, 88.
- 3) The injection channels 76, 88 do not intersect the separation channels 78. Instead, the separation channels 78 intersect the injection channels 76, 88, which is a different configuration than that recited in Claim 1.

With regard to Parce (U.S. Patent No. 5,958,203) the following claim limitations are not shown or described therein.

1) Parce merely teaches to provide a single separation channel, whereas the claimed subject matter comprises a plurality of separation channels. This difference is important since it is an object of the invention to provide an improved electrophoresis device with an increased number of separation channels (see page 4, paragraph 2 of the specification).

2) There is no application area provided at the crossing point of the separation channel and the injection channel.

It is also respectfully submitted that with respect to the rejection of Claims 1-9 based on Parce (U.S. Patent No. 5,958,203), Parce fails to provide or teach the recited elements missing from Sundberg et al., as described above. Moreover, no teaching or suggestion is present in either Parce or Sundberg et al. that the Parce device should be

modified, nor any incentive is provided as to why such a modification is desirable or even possible, other than the reason set forth in the Office Action, the general one which is the very improvement taught by this application. It is respectfully submitted that this is an impermissible standard for obviousness and is improper hindsight reasoning.

As is well known in making a determination of obviousness, the mere presence of the elements of a claim in the prior art, without a teaching reference or some type of incentive, other than that described and taught in the application being examined, is necessary to show the desirability and technical feasibility of the proposed combination of teachings taken from the references. It is insufficient to propose a mere "modification" of one teaching (Parce) in view of the teachings taken from another reference, for example, Sundberg et al. To simply state that the teachings of two disparate references are combinable, without providing reasons beyond those taught in the application specification, as to why the practitioner having ordinary skill in the art would be led to making the proposed combination, is contrary to the standards of obviousness.

For the above reasons, it is considered that the claims, as amended, find support in the application specification as filed, and that the combination of elements recited in the pending claims, as amended, distinguish over the references of record. Accordingly, reconsideration and withdrawal of the outstanding rejections are respectfully requested and indication of allowable subject matter is earnestly solicited.

Respectfully submitted,



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